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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,244	12/08/2003	Stephen C. Tulley	00-019-C1	2482
22927 7590 05/23/2008 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905				
EXAMINER				
LEIVA, FRANK M				
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3714				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/730,244

Applicant(s)

TULLEY ET AL.

Examiner

FRANK M. LEIVA

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-52-65 and 68-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-52-65 and 68-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. The examiner acknowledges claims 1-47, 49-51, 66 and 67 canceled in the applicant's submission filed 14 December 2007, and new claims 68-75.

Response to Arguments

2. Applicant's arguments filed 14 December 2007 have been fully considered but they are not persuasive. Arguments as follows.

3. Regarding the 35 U.S.C. §101 rejections the applicant's arguments are persuasive and withdrawn.

4. **Regarding claim 52** argument; *"This has nothing to do with, and does not remotely suggest, a player specifically requesting that a particular set of symbols be limited to a predetermined number of lottery tickets for a particular drawing. Nothing in Scanlon suggests a player actually making a request that any set of symbols be limited to only a particular number of tickets for a particular drawing"*, the examiner deems that the argument is not within the scope of the claim as written and that as such non-persuasive. Claim 52 broadest interpretation fails to include a definition to the phrase "exclusively associated", to mean that there is a direct connection between the subjects or objects discussed, It does not mean to eliminate other associations nor does it implicate to anything more that to purchase a ticket you have indicated for which drawing it is for and thus exclusively associating the ticket to a specific drawing.

5. **Regarding claim 52** argument; *"The Examiner even states that there were "a total 100 of tickets per number selection." Accordingly, if, as the Examiner states, the lottery authority dictated how many tickets were associated with each set of numbers, there is no*

suggestion on the Cuban Lottery tickets that any player could make any type of request related to how many occurrences could be associated with any particular set of symbols, much less that a player could request specifically that a particular set of symbols be associated with no more than a predetermined number of lottery tickets. Regardless of the number of tickets a player wanted to purchase, there appears to be, based on the Examiner's findings, nothing the player could do to request or otherwise influence the number of lottery tickets associated with a given "number selection.", the examiner points out that as shown in Cuban Lottery that the specific number shows in paper and printed 100 times with a serial number of each print from 1-100, it is more that obvious that if a person wishes to determine his share of the price by limiting the rest of the participants from purchasing that number, the person simply need to purchase the remainder of the tickets of that series. So if a player wishes to limit a particular series number of lottery tickets from the drawing the player simply needs to purchase all or part of the series printed. A request for information is simply to ask the vendor how many tickets of this number are available, and a determination is simply looking amongst the vendor tickets to see if the vendor has what the player is looking for. The rest is automation of the system already known.

6. **Regarding claim 52** argument, *"the Cuban Lottery tickets teaches imposing a limit on the number of duplicate tickets on all players, which is the opposite of allowing (or suggesting the desirability of) a player to request that a set of symbols be associated with no more than a predetermined number of lottery tickets for a given lottery drawing"*, examiner traverses that the idea is opposite, where the Lottery company may impose a limit on the amount of duplicate tickets do not follow that the opposite is that a player may also wish to limit the amount of duplicate tickets. The fact that both parties wish to limit the number of duplicates only confirms the idea of limiting the number of duplicates is advantageous for the player and very well-known.

7. **Regarding claim 48** argument, *"nothing in Scanlon or the Cuban Lotten/ tickets, alone or in combination, teaches or suggests a request by a player that a lottery number*

combination be exclusively associated with only a single lottery ticket for the lottery drawing", the examiner repeats the point of using "exclusively associated" as a term that narrows when by definition is a broad term and still broadens the scope of the claim to cover the references meaning. For example but not limited to a meaning would be to separate the tickets into two separate purchases, thus instead of purchasing the ticket with several combinations now that particular number combination is exclusively associated with an additional ticket. As is the broad language of claim 48 still reads on the art of record and rejected below.

Claim Rejections - 35 USC § 103

8. Claims 48, 52-65 and 68-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scanlon, (U.S. 4,922,522).

9. Regarding claims 48, 52 and 73-75; Scanlon discloses a method of facilitating a lottery ticket transaction, the lottery ticket being associated with a lottery number combination, comprising: receiving a request by a player to purchase a lottery ticket for a lottery drawing, (col. 2:57-63);

determining whether a request has been made by the player that the lottery number combination be exclusively associated with only a single lottery ticket for the lottery drawing, (col.5:18-33);

performing one of (a) or (b):

(a) if a request that the lottery number combination be exclusively associated with only a single lottery ticket has been made by the player, in response to the request by the player that the lottery number combination be exclusively associated with only a single lottery ticket for the lottery drawing, determining the lottery number combination such that the lottery number combination is exclusively associated with only a single lottery ticket for the lottery drawing, in which determining the lottery number combination comprises using a

random process to select at least one number of the lottery number combination; and preventing the lottery number combination from being associated with at least one additional lottery ticket for the lottery drawing, (col. 5:18-33 and 5:53-55) where the player can query if the number selection has been duplicated in another ticket and the system can be program to prohibit such duplicate tickets.

(b) if a request that the lottery number combination be exclusively associated with only a single lottery ticket has not been made by the player, determining the lottery number combination such that it is possible that at the time of the lottery drawing the lottery number combination could be associated with more than one lottery ticket for the lottery drawing, (col. 5:18-33); and

outputting an indication of the lottery number combination determined according to either (a) or (b), (col. 5:62-65).

10. **Regarding claim 53;** Scanlon discloses wherein the predetermined number of lottery tickets is one lottery ticket, (col. 5:53-55).

11. **Regarding claim 54;** Scanlon discloses further comprising: preventing at least one lottery ticket from being associated with the determined set of symbols, (col. 5:53-55).

12. **Regarding claim 55;** Scanlon discloses further comprising: determining a lottery ticket identifier, (col. 5:56-65).

13. **Regarding claim 56;** Scanlon discloses further comprising: transmitting an indication of the lottery ticket identifier to the lottery terminal, (col. 5:56-65).

14. **Regarding claim 57;** Scanlon discloses wherein determining the set of symbols comprises: determining a set of symbols that has not previously been associated with any lottery ticket with respect to the drawing, (col. 5:18-33) where the process of selecting numbers is followed by a search for duplicate number selections and allowing the user to cancel and select another set.

15. **Regarding claim 58;** Scanlon discloses further comprising: preventing at least one lottery ticket from being associated with the determined set of symbols, (col. 5:53-55).
16. **Regarding claim 59;** Scanlon discloses further comprising: storing an indication of a price for the lottery ticket, (col. 2:57-63) the billing process.
17. **Regarding claim 60;** Scanlon discloses further comprising: determining the price based on the predetermined number of lottery tickets, (col. 2:57-63) the billing process.
18. **Regarding claim 61;** Scanlon discloses further comprising: determining the price based on the received indication, (col. 2:57-63).
19. **Regarding claim 62;** Scanlon discloses wherein determining the set of symbols comprises: randomly determining the set of symbols, (col. 4:21-24).
20. **Regarding claim 63;** Scanlon discloses further comprising: verifying that the randomly determined set of symbols has not previously been associated with at least one other lottery ticket for the drawing, (col. 5:18-33).
21. **Regarding claim 64;** Scanlon discloses further comprising: preventing at least one lottery ticket from being associated with the randomly determined set of symbols, (col. 5:53-55).
22. **Regarding claim 65;** Scanlon discloses further comprising: printing a lottery ticket that includes the determined set of symbols, (5:56-65).
23. **Regarding claim 68;** Scanlon discloses 68. (NEW) The method of claim 52, in which the predetermined number is selected by the player.

24. **Regarding claim 69;** Scanlon discloses in which the predetermined number is not selected by a lottery authority, (col. 4:21-24), where the system allows for both manual and automatic selection of numbers.
25. **Regarding claim 70;** Scanlon discloses further comprising: receiving, from the lottery terminal, an indication of a selection by the player of the predetermined number from a plurality of available options, (col. 4:21-24) see claim 69.
26. **Regarding claim 71;** Scanlon discloses in which the plurality of available options includes an option to have no maximum number, as mention above if the system allows you to limit the number of duplicates, by not choosing to limit the player is in fact opening his ticket to be duplicated without limit.
27. **Regarding claim 72;** Scanlon discloses in which the plurality of available options is predetermined by a lottery authority, (col. 1:10-20), where is well-know for lotteries to be state run and thus having lottery authorities oversee and regulate all aspects of the system to protect the customers.

Double Patenting

28. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d

937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

29. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-124 of copending **Application No. 11/424155**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

30. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-145 of copending **Application No. 11/424162**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

31. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-122 of copending **Application No. 11/424166**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

32. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-78 of copending **Application No. 11/531735**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

33. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-71 of copending **Application No. 11/531741**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

34. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-72 of copending **Application No. 11/531744**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

35. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-72 of copending **Application No. 11/531749**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

36. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-90 of copending **Application No. 11/531754**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

37. These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Conclusion

38. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK M. LEIVA whose telephone number is (571)272-2460. The examiner can normally be reached on M-Th 9:30am - 5:pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

FML 05/22/2008